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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,646	01/23/2001	Youji Kohda	1405.1032/JDH	4296
21171	7590	10/30/2008		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	
			MAIL DATE	DELIVERY MODE
			10/30/2008	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/766,646
Filing Date: January 23, 2001
Appellant(s): KOHDA ET AL.

Mehdi Sheikerz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/12/2008 appealing from the Office action mailed 11/6/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

NEW GROUND(S) OF REJECTION

Claims 1, 6-10, 23-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 6-10 and 23-26 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a

different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1, 6-10 and 23-26 fail to meet the above requirements.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Hunt	6,223,215	4-2001
Hoyle	2005/0005242	1-2005
Allibhoy	2004/0172343	9-2004
Notz	7,016,864	3-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-12, 14-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt (6,223,215) in view of Hoyle (2005/0005242) in view of Allibhoy (2004/0172343) in view of Notz (7,016,864).

As per independent claim 1, Hunt (the ABSTRACT; FIG. 1; through FIG. 10; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 30-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-15; and whole document) shows elements and limitations of claim 1.

As per dependent claims 2-10, Hunt shows the method of claim 1 and subsequent base claims depending from claim 1.

Hunt (the ABSTRACT; FIG. 1; through FIG. 10; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 30-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-15; and whole document) implicitly shows all of the elements and limitations of claims 2-10; however,

Independent claims 11, 12, 14, 21-23 are rejected for substantially the same reasons as independent claim 1.

As per dependent claims 15-20, Hunt shows the method of claim 14 and subsequent base claims depending from claim 14.

Hunt (the ABSTRACT; FIG. 1; through FIG. 10; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 30-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-15; and whole document) shows the elements and limitations of claims 15-20.

As per dependent claims 24-26, Hunt shows the method of claim 23.

Hunt (the ABSTRACT; FIG. 1; through FIG. 10; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 30-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-15; and whole document) shows elements and limitations of claims 24-26.

Additionally, Hunt discloses purchasing (col 1, lines 47-51).

Hunt discloses online shopping, the utilization of a shopping cart, and the user seeking further product related information (col. 2, lines 32-50; and col. 1, lines 35-60).

Hunt's discloses utilization of a shopping cart for shopping involving multiple and varied items as stated above.

Hunt does not explicitly disclose providing additional information on items that can be placed in shopping carts or presenting information from numerous sources on item(s) of interest to a user/purchaser.

However, Hoyle discloses placing items in a shopping cart and that the user can receive more information on items of interest in the shopping cart:

"[0155] The present invention also provides the user with an efficient and effective way to shop on line; by creating a kind of global electronic shopping cart which can be used to electronically accumulate items for purchase from any of a number of different sellers and distributors. The shopping cart can be implemented as one or more files stored on the server as a part of the user library and the client software application can be configured to manage the information stored in the shopping cart. Then, for example, when a user browsing on the Internet or other network decides that they wish to purchase a product, suitable purchasing information can be added to the shopping cart. This action can be carried out by selection of an appropriate icon or menu command on the software client application's graphical user interface. Optionally, the icon could be located on a web site itself or the menu command could be added to a menu that is accessible using a mouse, such as by activation of the right button on the mouse. The product information, including pricing and the necessary purchasing information can be made available by the web site to the client software application. Also, the URL of the site containing the product information can be stored in the shopping cart to enable the user to easily return to the site at a later time to review product information. For electronic product information available from other sources, such as set-top television box, the user can select items shown in a television program, television advertisement, or other type of visual advertisement, with an associated URL or other information then being added to the shopping cart. The information added to the shopping cart can be broadcasted along with the television program and then saved in the shopping cart when selected by the user. The user can

then review the contents of the shopping cart at a later time, adding and removing items from the cart as desired, reviewing the total purchase price and taxes calculated and displayed by the software, and then making a final purchase. The user profile can include credit card, mailing address, and other such information to enable the purchase of products in the shopping cart without the user having to enter the information each time a purchase is made. As will be appreciated, this permits the user to add items to the cart from different sellers or distributors and without having to make a final purchase decision at that time and without having to attend to actually purchasing the items until a later time when the contents of the entire cart can be examined".

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hoyle's providing additional information on items that can be placed in shopping carts to Hunt's utilization of a shopping cart for shopping involving multiple and varied items. One would have been motivated to do this in order to provide the user with relevant information on items of interest.

Additionally, the combination of the prior art renders obvious designating a third party which the first user permits to view the cart identification information and to view product information which the first user associates with the cart identification information.

The combination of the prior art renders obvious the features which have been priorly stated above. The features which have been priorly stated as rendered obvious by the combination of the prior art above are also assumed for the features that are disclosed below.

Hunt further discloses the tracking user activity across a range of time and correlating it with a variety of information:

“(18)... The session ID is embedded in the Domain field, which allows cross-application interaction and, in particular, allows for online or offline correlation of user action data across the seam between the catalog subsystem and the purchase subsystem. For example, the association of the digital offer data with the unique session ID will allow a separately developed reporting tool to correlate details of a sale with the inbound source, user action at the network site, and net sale data. The Domain field can also contain other application-specific information” (col 6, lines 48-60).

Hunt does not explicitly disclose the user designating a third party that the user agrees can track and target the user.

However, Hoyle discloses that the user can register with a third party, that the user registration with a third party can be optional, that user registration can include the user sharing a variety of user information with a third party, that along with the user registration the third party can monitor user activity including user shopping related activity, that targeted information can be provided to the user by the third party based on the known user information, that in registering the user designates a third party that the user agrees can track and target the user:

“[72]. . .In addition, features are provided to deliver advertising (e.g., banner advertising) to users based on demographic and computer usage information or data captured from users (e.g., data supplied by users during registration, and demographic and

usage demographic data captured from information obtained based on web site visitation, applications employed, and other usage data); and that targeted advertising can be displayed to those users during the course of use of the computer by those individual users, irrespective of whether those users are connected to a network (i.e., are online) or whether those users are using the computer for a non-network application (i.e., are offline).

[87]. . . Other basic commands that can be available for view and use (but are not shown) include access to a menu that identifies guest users registered on a particular account, a search button that invokes a web browser to which the user has access to connect to a web site or a search engine, and a menu item that allows initiation of procedures for user registration. This menu item can be labeled, for example, as a "User" menu item; and can be used to allow an initial user to identify, add or delete guest users, as well as to also allow the user to relinquish control of the application (i.e., cancel the service). . . A menu item labeled "Help" invokes a context-sensitive help facility for the user, provides information about the product, provides information regarding the capabilities of the product, and provides pointer-based direction to the user.

[0104] Login module 60 (FIG. 4) comprises an ActiveX.TM. or Java.TM. login component which includes the programming that provides the user login and password validation features. If desired, this module can also include a security component that provides encryption of data transmitted over the Internet. PDA module 62 is an ActiveX.TM. or Java.TM. component that can be used to handle importing and exporting of user data between the client software application and the formats needed for use with a personal digital assistant. Also, this module can be used for interfacing the client software

application with the user's current personal information management software, such as Outlook.TM., Lotus Notes.TM., or Netscape.TM. mail. The security module can also include an import/export wizard for use by the user in converting between formats.

[0119] Referring now to FIG. 8, the process for providing access to the client software application and for obtaining and utilizing demographic information regarding the user will now be described. As will be appreciated, the software download and data gathering process of FIG. 8 can be implemented by a suitable server program residing on ADM server 22. As indicated at blocks 132 and 134, in response to server 22 receiving a download request from a user, the server sends a form to the user and then waits for the completed form to be posted back to the server. The form can include a number of required fields that provide the minimum data needed to generate a proper demographic profile of the user. Exemplary user information includes age, sex, region of residence, education level, occupation, interests and hobbies, recent major purchases, income level, and the like. Other information that can be provided includes identity of computer network service, electronic mail service, computer and monitor type, computer operating system, browser application, and the like. Personal information, that is used for accounting and user identity purposes for future usage, but most preferably not for targeted banner advertising purpose, include name, address, user name and password of the user. Other information regarding the user includes whether the user is an initial user or a guest user. Other personal information, such as credit card information also can be provided. However, such information can be maintained within a secure location within the server, and not used in other network transactions, such as over the Internet. For example, credit

card information can be maintained in a secure location within a user's personal profile; commercial transactions initiated by the user can be transacted by ultimate transfer of the credit card information between computers in a secure manner (e.g., between the server and a computer authorized to conduct, in a secure manner, collection for credit card based transactions).

[0120] Once server 22 has received the completed form, a check is made to determine whether all of the required fields have been completed, as indicated at block 136. This check can include a certain amount of validity checking of the data. For example, if the user is required to specify the city and state in which they live, a check could be made to determine whether the city and state reported by the user actually exists. Similarly, a reported area code could be checked to determine its validity. If required information is missing or invalid, flow moves to block 138 where the server resends the form with a request for correction. As is known, this can include an identification of the particular required data that was missing or invalid. Once server 22 receives a correctly completed form, flow moves to block 140 where server 22 assigns a unique ID to the user and then stores that ID along with the received demographic data, as indicated at block 142. As discussed above in connection with FIG. 3, this data is stored in the user/demographics data base 46. Then, an initial set of banner advertisements and links are selected based upon the user's zip code, indicated at block 144. The links are used to provide an initial set of links for each of the bookmark categories represented by icons 80. Thereafter, client software application 10 is downloaded to the user's computer for

installation by the user, as indicated at block 146. Preferably, the client software application is packaged as a single, self-extracting ZIP file and includes an installation program that handles installation of the program and all of its components into proper directories, as well as making the necessary entries into the Windows.TM. Registry.

[121] ... The application declares itself a new installation of a client software application, and the server provides an identifier for subsequent identifications between the application and the server. User identification provides individual users with the ability to receive advertising banners that are specifically targeted to a specific user from among multiple users that may be registered at a particular computer or through a client software application; as well as the ability to ensure that the set of applications shortcuts, web hyperlink channels, and the organization of resources set up by an individual user are reproduced when that specific user's accesses the client software application.

[0125] As shown in FIG. 9, upon execution of the client software application 10, a login and password input box is displayed. This is shown at block 148. Once the user has entered a login name, a check is made at block 150 to determine whether the user name is new. If not, a check is made at block 152 to determine whether the password provided for the recognized login name is correct. If not, flow returns to block 148 where the login box is again displayed. If the password is correct, flow moves to block 154 where the application accesses the user's set of preferences and customizations for the display of the graphical user interface. The application also accesses the banner database and various bookmark categories for that user which, as described above, contains for each category of information a number of links to different information resources. Flow then moves to block

156 where the graphical user interface is displayed along with a first banner. The login names and associated passwords can be stored in the user data storage 34. Similarly, the user preferences, categorized lists of bookmarks, and banner database can be stored in user data storage 34. Optionally, the login and password are used to provide an identification of the user to the server 22 so that the user profile and user library may be accessed and incorporated into the graphical user interface provided by the client software application.

[0136] The client and user registration module 338 provides the capabilities required to establish a new user or to establish an existing user who has moved to a different computer. The user services module 340 provides the capabilities required to interact with the components of the client software of the user's computer in order to implement and manage the features and benefits realized at the user's computer. The user services module 340 provides for recordation of usage information, delivery of targeted advertising material to users, support of network bookmarks for the user, and applications support for the user. The advertiser services module 342 provides those capabilities required to deliver services required in support of advertisers employing the system for the purpose of delivering advertising to users. The advertiser services module 342 provides for capture and maintenance of advertiser registration information, management of advertiser account status, receipt of advertising material, presentation of user demographic data, and management of targeting advertising designations. . .

[0137] The client and user registration module 338 maintains a list of users registered to use a particular installation of the relevant software, and transfers updates to the list to

the server 22, and it is possible that a user can possess more than one installation. One user of the installation is recognized as the owning user of the installation. At any time that the application is active, it will have identified a current user from the list of users registered for that installation. As such, the module thus invokes the user profile of the particular, current user. When the application is used on a computer using an operating system such as WindowsNT, or any other operating system environment that enforces rigorous access controls, it can use the user identity derived from the Windows NT log-in procedures. For example, the application can match the Windows NT log-in identity against a table of users registered for that machine, and can invoke the user profile of the user who has previously worked under that Windows NT identity. In addition, the application can use the Windows NT user profile facility to derive correspondence between Windows NT users and users of the application. When the application is used on a computer using an operating system such as Windows 98, Windows 95, or Windows 3.1, or any other operating system environment that lacks rigorous access controls, the application can prompt the user for the user identity and password. For example, the application can maintain a listing of users registered for a particular computer, and can invoke the user profile of an individual user so identified. Optionally, an individual user of an application installation can turn off the user identification capabilities, and in that case the user profile of that user can always be invoked without prompting.

[0147] A previously registered user using a new (or previously unregistered) computer can register. A user providing information shall be granted access to the server, and the server shall retrieve all of the user profile data from the server. Optionally, the user

can provide information to provide an updated profile, which then is stored by the server. Typically, the first user to register on a computer shall be designated as the first user; and subsequent users of that installation can be recorded as guest users of that installation. Such an aspect of the present invention is particularly preferred, because a previous user can access personal information from any computer having network access, such as Internet access. In certain circumstances, the initial user can be a parent of a family, a corporation, or the management of an organization, and as such, the initial user can remove guest users from the system. In the event that a user does not expect to use a particular computer again (e.g., such as a computer located in a courtesy business area at an airport), the user can have the option to register as a temporary user, providing of profile information is optional, and no personal profile is maintained on the server for that user.

[137]...Optionally, an individual user of an application installation can turn off the user identification capabilities, and in that case the user profile of that user can always be invoked without prompting".

Note particularly in paragraphs [125, 147, 137] that list of users who have given their information to the third party such the third party can track and target the user(s) is disclosed. Also, note that the user can decide whether or not to register with the third party and that the user can utilize the system without providing to the third party user information that is used for tracking and targeting the user. Also, note in Hoyle that the third party is the party which the user registers with and which tracks and targets the user. Hence, the user in Hoyle's disclosure designates a third party which the first user permits to view a

variety of user information and activity including information and activity related to user shopping and purchasing, tracking, and targeting.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hoyle's user designating a third party that the user agrees can track and target the user to Hunt's tracking and targeting a user. One would have been motivated to do this in order to better track and target the user by having a user who has more relevant information available for tracking and targeting of the user.

Additionally, Allibhoy discloses e-commerce, an electronic shopping cart, third party content providers, that the user can request more information on a product, cross-selling, advertising associated with shopping carts (Abstract; Fig. 1; Fig. 2; Fig. 3; Fig. 7; Paragraph [14]).

Also, Allibhoy further discloses the third party or the user being able to designate which content providers the user will receive further information from ([69, 80, 93, 159]). Notice in these citations that the user can indicate explicitly which brands, companies, preferences, etc that the user is interested in receiving more information about.

Also, Allibhoy further discloses that the User can request additional information on items, products, or items/products in a shopping cart ([75, 76, 80, 82, 94]; claim 13, claim 25).

Also, Allibhoy further discloses branding and advertising related to a shopping cart ([128, 124]).

Also, Allibhoy further discloses cross-selling and cross-selling related to a shopping cart ([16, 125]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Allibhoy's designating a content provider of interest and providing additional information on items that can be placed in shopping carts and/or cross-selling related to items that can be placed in shopping carts to Hunt's utilization of an electronic shopping cart for shopping involving multiple and varied items. One would have been motivated to do this in order to provide the user with relevant information on items of interest.

Additionally, Hunt tracks all cart related activity (Fig. 4).

And, Allibhoy allows extensive cart tracking by the information provider who is the controller and also real-time additional information providing relevant to the shopping cart by the controller (Fig. 1; Fig. 3; [75]). Allibhoy also discloses control over who is allowed to communicate with the user ([9]).

And, Allibhoy discloses that the content provider/seller is connected to the user through the same network as the controller (Fig. 1). Also, note in Fig. 1 that the content provider does not have to go through the controller to communicate with the receiver/user/buyer.

Allibhoy also discloses cross-selling and targeted advertising related to the shopping cart:

"[16]. . . The profile can also be used for cross-selling purposes and to target advertising, such as that which may be included in the Shopping Cart screens, to a specific user."

Allibhoy also discloses transactions involving a shopping cart between a user and content provider:

"[0013] According to yet another aspect of the invention, transactional information between an end user and a Content Provider is stored within a Shopping Cart under the control of the Controller."

Allibhoy also discloses direct communications/transactions between a user and content provider:

"[0012] According to yet another aspect of the invention, the Controller allows user transaction requests to go directly to the designated Content Provider. If the Content Provider appends the required markers to the programming and abides by the system requirements, the programming is allowed to pass to the end user, thus completing this phase of the transaction"

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Allibhoy's disclosed cross-selling, further information providing to the user, direct communication network between a content provider and user, direct communications/transactions between a content provider and user can also include communications during the time of shopping cart use as the controller already performs. One would have been motivated to do this in order to allow the user further information of relevance and also better communications.

Also, the MPEP 2144.04.VI. discloses that reversal, duplication, or rearrangement of parts is obvious. Therefore, it is obvious that the content provider can also communicate with the user during a cart transaction as the controller does.

Also, Allibhoy discloses determining whether the received additional information is from the product provider which the first user permits to view the cart identification information and to view the product information associated with the cart identification information (all of paragraph [69 and 9] and also this particular citation from [9]):

"[9]. . .First, Content Provider access to the network can be limited to authorized Content Providers, authorization typically being given to those Content Providers that

agree to a specific programming format and/or agree to a fee arrangement with the Network Operator. Second, the triggers/markers can be used for filtering purposes, allowing the end user, the Network Operator, the Controller, or other party to filter the enhanced content programming that is provided to a specific end user".

Additionally, in regards to the features of allowing the third party product providers to send content to the user only after receiving permission from the user, Hoyle discloses the user being able to indicate which categories of information to receive or not receive ([51-53]). Also, Hoyle discloses the user being able to indicate a guest user who are able to see the account ([87, 147]). Also, notice in these citations that a large number of guest users can be indicated say in the example of a corporation, etc.

Additionally, Allibhoy disclose allowing the third party product providers to send content to the user only after receiving permission from the user:

"[claim] 16. . permitting the network transaction to proceed if the content provider abides by said third party parameters;

[Claim] 19. The method of claim 16, wherein said third party parameters include a user profile associated with said receiver."

Allibhoy further discloses allowing the third party product providers to send content to the user only after receiving permission from the user here:

"[0159] In at least one embodiment of the invention, as illustrated in FIG. 12, a trigger information filter is defined (step 1201), either explicitly by the user or implicitly by the user's profile. Preferably the information filter is explicitly set, thus allowing the user to change the filter frequently depending upon current needs. Once set, ATV Controller 109 monitors all possible sources, including both those associated with the channel being viewed and those associated with other channels, for triggers meeting the criteria (step

1203). Once a trigger meeting the criteria is detected, the user is notified (step 1205), typically using a screen graphic or an audible signal. Alternately, the system can be configured to immediately present the user with any information meeting the preset criteria (step 1207)."

Also, notice that the trigger can be an indicator for a specific Content Provider:

"[0137] As previously described, triggers and other types of markers routinely accompany enhanced content programming and other types of data streams. These triggers can be used to provide a resource locator, an indicator of resource availability, a resource content identifier, a Content Provider indicator, etc. . . The triggers or markers can also be used in a variety of other ways, both in conjunction with, and separate from, the basic invention, as described further below.

[0162] It is understood that the criteria for the filter (step 1203) may be comprised of a variety of different types of information. For example, in addition to simply defining the topic of interest (e.g., draft choices for a local football team), the user may also wish to only monitor certain channels (e.g., a local channel, a headline news service, a sports broadcast service, etc.) and certain information types (e.g., news). The user may also wish to set the media type (e.g., standard broadcast programming, Web based information, etc.)."

Hence, Allibhoy discloses permitting the network transaction to proceed if the content provider abides by said third party parameters; wherein said third party parameters include a user profile associated with said receiver. And, Allibhoy discloses that the user can

control their profile directly and with a wide range of parameters. And, Allibhoy discloses that one of the parameters can be a particular Content Provider.

Also, note in Allibhoy that the user can change their profile ([141]).

Also, note that Allibhoy discloses a shopping cart where further information from third parties can be obtained and presented to the user. Also, note that the user can change their profiler and that authorizations from the user may be necessary [80].

Also, note that the user can control the user profile and the user profile can be a filter that requires authorizations for certain transactions :

"[0094] . . . Then, on the basis of the rating (or other characteristic) and the user's previously entered profile, ATV Controller 109 can allow the transaction to move forward, void the transaction, or request additional information. The requested additional information can include authorization to continue, for example by including a password or PIN number in the transaction request. By controlling the password, PIN number, or other authorization code a parent, guardian, or other authority can control the transactions, including purchases, permitted on a specific Receiver 103. Similarly, a password, PIN number, or other authorization code can be used to control all transactions or any predefined subset of transactions, thus allowing the user to enforce rules associated with their Receiver 103 (e.g., budgets, ratings, etc.)"

Also, note in Allibhoy that the Controller or the end user can be the filtering party that controls the triggers:

"[0009] Second, the triggers/markers can be used for filtering purposes, allowing the end user, the Network Operator, the Controller, or other party to filter the enhanced content programming that is provided to a specific end user."

Hence, Allibhoy discloses allowing the third party product providers to send content to the user only after receiving permission from the user.

Hence, the combination of the prior art renders obvious allowing the third party product providers to send content to the user only after receiving permission from the user.

Hence, the combination of the prior art renders obvious the features of the Applicant's claims.

Please see the preceding.

Additionally, Hunt further discloses tracking all cart related activity (Fig. 4).

Hunt does not explicitly disclose that a vendor/seller can see the user's cart and make further recommendations/provide further information/upsell/cross-sell.

Additionally, Notz discloses a merchant/seller being able to see the cart and make an upsell recommendation (col 9, lines 20-36; col 10, lines 10-25).

And, Notz discloses that only authorized third parties can access the user shopping cart (col 9, lines 37-44; col 10, lines 10-25). And, Notz discloses that a series of business rules can control how or who accesses the shopping cart (col 9, lines 15-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Notz vendor upsell/further information to Hunt's cart with tracking. One would have been motivated to do this in order to better utilize the cart for providing information and making purchases.

Additionally, Allibhoy discloses that the third party can be related to the products directly or indirectly. Allibhoy does disclose a shopping cart with products that the user is looking/considering to purchase (Figure 3; [77-86]). Also, notice that these citations include "goods or services", "quantities", back-order dates, expected shipping dates. And, Allibhoy cross-selling and targeting related to the profile and shopping cart content ([16]). Notice that cross-selling can be for indirectly related products. Also, Allibhoy discloses providing additional information related to the shopping cart and shopping cart contents from third parties/content providers. Also, notice that a shopping cart need not have products all have from the same company. Various and diverse items can be in the shopping cart. Hence, there can be more that one third party/company/manufacture/product provider be represented by the items in the cart. And, in Allibhoy, there is more than one third party or content provider and, also, different content providers can provide "additional information" to the user ([2, 3]).

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 6-10 and 23-26 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a

different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1, 6-10 and 23-26 fail to meet the above requirements.

(10) Response to Argument

Examiner notes that the combination of the prior art renders obvious the features of the Appellant's independent claim 1.

In reference to independent claim 1, the combination of the prior art renders obvious: associating cart identification information with a first user (Hunt, Fig. 4, item 404; Fig. 2, item 202, item 208, item 214);

receiving, from the first user, designation information of a third party product provider which the first user permits to view the cart identification information and to view product information which the first user associates with the cart identification information, and which provides a product related to the viewed product information as well as additional information related to the viewed product information, said third party product provider not having permission to view the cart identification and product information before receipt of the designation information (Allibhoy, [3], claim 16, claim 19);

associating and storing the designation information with the cart identification information (Hunt, Fig. 4, item 404; Fig. 2, item 202, item 208, item 214);

receiving product information on said product from the first user (Allibhoy, [80]);
associating said product information with the cart identification information (Hunt, Fig. 4, item 404; Allibhoy, [80]);

notifying said third party product provider associated with said cart identification information of said cart identification information and product information in accordance with a receipt of designation information of said third party product provider or a receipt of said product information (Allibhoy [80], Notz);

receiving additional information regarding the product identified by said product information, and the cart identification information, from said third party product provider (Allibhoy [3], Notz, col 10, lines 10-18);

determining whether the received additional information is from the third party product provider which the first user permits to view the cart identification information and to view the product information associated with the cart identification information (Allibhoy, claim 16, claim 19);

associating said received additional information with said cart identification information according to the determination result (Allibhoy [80]); and

notifying said first user of said received product information and additional information (Allibhoy [80]).

And, the preceding is obvious in light of the rejection above.

On page 21 of the Appellant's Appeal Brief dated 9/12/2008, Appellant states that the combination of the prior art does not render obvious:

"receiving, from the first user, designation information of a third party product provider which the first user permits to view the cart identification information and to view product information which the first user associates with the cart identification information, and which provides a product related to the viewed product information as well as additional information related to the viewed product information, said third party product provider not having permission to view the cart identification and product information before receipt of the designation information."

Examiner notes that whether or not the combination of the prior art renders obvious these features is the Appellant's focus of argument. Hence, the Examiner shall focus on how the prior art renders obvious these features.

Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In interpreting claim language, the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art is applied, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. See *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). See also *In ream. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) and *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000). It is Appellant's burden to precisely define the invention. See *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Appellant's Specification states that the third party can be the party who manufactures or provides the products in the user's cart (Appellant's Fig. 20b; [21, 27]). Notice in Fig. 20b that that Kao company communicates with the shopper and that is also the Kao company's product that is in the shoppers cart. Also, the citations nor claims prevent the third party from being the same party as the manufacturer of the products in the shoppers cart. Hence, the first party is the shopper, the second party is the cart provider or shopping website, and the third party is any product provider or advertiser. And, the third party can be the same party as the product in the shopper's cart or it can be a competitor company to a product in the shopper's cart.

And, Allibhoy discloses the user utilizing a shopping cart (Fig. 3, "User Selects Product/Service to Be Purchased", "Purchased Entered into ATV Shopping Cart"). Allibhoy further discloses that the user can receive further information on the products in the user's shopping cart (Fig. 3, "Does User Want More Information?", "ATV Controller Supplies User with Additional Information"). And, Allibhoy discloses a third party who the user can receive additional information from on a product the user is purchasing:

"[3]...Accordingly a user can request additional information or purchase goods and services from a third party that is only indirectly affiliated with the network and its operator.

[0054] According to the invention, coupled to Network Operator 101 is an ATV (Accelerate TV) Controller 109. Controller 109 allows Network Operator 101 to control and audit the interactions between Receivers 103 and Content Providers 105. Additionally, ATV Controller 109 allows Network Operator 101 to enforce various business rules, thereby insuring that Content Providers 105 present information to user devices 103 with

an acceptable look and feel. Controllable transactions include, but are not limited to, e-commerce, interactive advertising, polling, couponing, lead generation, etc. which flow between Receivers 103 and a specific Content Provider 105 via the network and Network Operator. "

And, Allibhoy discloses that the user can designate which third parties/content providers are allowed to interact with the user or see the user's shopping cart or not. Allibhoy disclose allowing the third party product providers to send content to the user only after receiving permission from the user:

"[claim] 16. . .permitting the network transaction to proceed if the content provider abides by said third party parameters;

[Claim] 19. The method of claim 16, wherein said third party parameters include a user profile associated with said receiver."

Allibhoy further discloses allowing the third party product providers to send content to the user only after receiving permission from the user here:

"[0159] In at least one embodiment of the invention, as illustrated in FIG. 12, a trigger information filter is defined (step 1201), either explicitly by the user or implicitly by the user's profile. Preferably the information filter is explicitly set, thus allowing the user to change the filter frequently depending upon current needs. Once set, ATV Controller 109 monitors all possible sources...for triggers meeting the criteria (step 1203). . .the system can be configured to immediately present the user with any information meeting the preset criteria (step 1207)."

Also, notice that the trigger can be an indicator for a specific Content Provider or Content Provider types:

"[0137] As previously described, triggers and other types of markers routinely accompany enhanced content programming and other types of data streams. These triggers can be used to provide a resource locator, an indicator of resource availability, a resource content identifier, a Content Provider indicator, etc. . . The triggers or markers can also be used in a variety of other ways. . .".

[0162] It is understood that the criteria for the filter (step 1203) may be comprised of a variety of different types of information. For example, in addition to simply defining the topic of interest (e.g., draft choices for a local football team), the user may also wish to only monitor certain channels (e.g., a local channel, a headline news service, a sports broadcast service, etc.) and certain information types (e.g., news). The user may also wish to set the media type (e.g., standard broadcast programming, Web based information, etc.),"

Also, further note in Allibhoy that the Controller or the end user can be the filtering party that controls the triggers:

"[0009] Second, the triggers/markers can be used for filtering purposes, allowing the end user, the Network Operator, the Controller, or other party to filter the enhanced content programming that is provided to a specific end user."

Hence, Allibhoy discloses allowing the third party product providers to send content to the user only after receiving permission from the user.

Hence, Allibhoy discloses permitting the network transaction to proceed if the content provider abides by said third party parameters; wherein said third party parameters include a user profile associated with said receiver. And, Allibhoy discloses that the user can control their profile directly and with a wide range of parameters. And, Allibhoy discloses that one of the parameters can be a particular Content Provider.

Hence, as shown above, Allibhoy discloses receiving, from the first user, designation information of a third party product provider which the first user permits to communicate with the user, and which provides a product related to the viewed product information as well as additional information related to the viewed product information, said third party product provider not having permission to communicate with the user before receipt of the designation information.

Allibhoy does not explicitly disclose that the Content Provider sees the shoppers shopping cart when communicating with the shopper.

However, Allibhoy discloses that the Controller sees the shoppers shopping cart and communicates with the user to provide further product information:

"[0080] As previously described, ATV Controller 109 maintains a data base containing pertinent information on each item or transaction within the Shopping Cart. The user may elect to view the additional information for any particular product or transaction (step 305), preferably by highlighting the product or transaction within the Shopping Cart and indicating that they want additional information (for example, by "pressing" an "additional info." Button within a Shopping Cart menu). ATV Controller 109 then supplies the user with the requested additional information (step 307)."

And, Allibhoy discloses Content Provider advertising or product information being placed on the screen while the shopper is viewing a shopping cart and that the advertising can link to further information from the Content Provider:

"[0014] According to yet another aspect of the invention, the data screens associated with the Shopping Cart include advertising, the advertising covering some portion of each data screen. The advertising may be either static or dynamic and may include linking information to specific Content Providers offering the branded goods or services."

Also, in Allibhoy the Content Provider/seller is connected to the shopper through the same network as the Controller (Fig. 1). And, note in Fig. 1 that the Content Provider does not have to go through the Controller to communicate with the Shopper. Rather, as shown in Figure 1 of Allibhoy, the Content Provider can communicate with the Shopper directly.

Also, the user/shopper can interact with the Content Provider directly:

"[0012] According to yet another aspect of the invention, the Controller allows user transaction requests to go directly to the designated Content Provider."

Also, the user/shopper can purchase products from the Content Provider, or request further information from the Content Provider:

"[0073] . . . Alternately, the user can elect to proceed with the interaction, for example by selecting to purchase the product or service presented by Content Provider 105 (step 243). It is understood that at this juncture, depending upon the type of interaction between the user and the Content Provider, other options may be available. For example, the user may request additional information (e.g., product specifications, available colors, models, etc.) on a displayed product at this time (step 245), resulting in a new request for

information being sent to the Content Provider (step 246). Examples of other reasons for additional user requests include polling interactions, refining the initial user request, etc. When the user requests additional information, ATV Controller 109 continues to monitor the transaction and, to at least a limited extent, continues to direct the flow of information to and from the Receiver 103 and the designated Content Provider 105. During these subsequent interactions, it is typically no longer necessary to confirm that the designated Content Provider 105 is an authorized Content Provider.”

Hence, as stated on page 17 of the Final Rejection dated 11/6/07:

“Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Allibhoy’s disclosed cross-selling, further information providing to the user[shopper], direct communication network between a content provider and user[shopper], direct communications/transactions between a content provider and user[shopper] can also include communications during the time of shopping cart use as the controller already performs. One would have been motivated to do this in order to allow the user[shopper] further information of relevance and also better communications.”

Also, the MPEP 2144.04.VI. discloses that reversal, duplication, or rearrangement of parts is obvious. Therefore, it is obvious that the content provider can also communicate with the user during a cart transaction as the controller does.

And, Notz further discloses an authorized merchant being able to make upsell recommendations:

“Recommendations are preferably dynamic, wherein authorized business personnel of the online store merchant can add/change/delete active upsell recommendations at any

time during any given day. Sequencing of the active upsell recommendations is used for advantageously enhancing business sales" (col 10, lines 10-18).

Hence, it is obvious that the Allibhoy's Content Provider, who already communicates with shopper directly, provides further product information, and advertises to the shopper during shopping, can see the shopper's cart as the Controller of Allibhoy or the merchant of Notz does.

Hence, the combination of the prior art renders obvious receiving, from the first user, designation information of a third party product provider which the first user permits to view the cart identification information and to view product information which the first user associates with the cart identification information, and which provides a product related to the viewed product information as well as additional information related to the viewed product information, said third party product provider not having permission to view the cart identification and product information before receipt of the designation information.

Also, Examiner will respond in terms of motivation for combining the prior art.

Examiner notes that "Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" KSR Int'l Co. v. TeleflexInc., 127 S.Ct. 1727, 1734 (2007).

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated

success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR, 127 S.Ct. at 1739 and 1741, 82 USPQ2d at 1396.

And, all the features of the Appellant's claims are already present in the prior art as shown above. And, the prior art is analogous. Each piece of the prior art utilized in the 103 rejection focuses on utilizing Shopping Carts during e-commerce. And, each piece of prior art focuses on how to better utilize and assist the shoppers and merchants utilizing Shopping Carts during e-commerce.

Hence, the combination of the prior art renders obvious the features of the Appellant's claims and there is motivation under 35 USC 103 to combine the references.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Arthur Duran/
Primary Examiner, Art Unit 3622

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

**/Wynn W. Coggins/
Director, TC 3600**

Conferees:

Eric Stamber /E. W. S./
Supervisory Patent Examiner, Art Unit 3622

Vincent Millin /VM/

Appeals practice Specialist